



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/162,984	12/08/93	DOUBOURD	H- 10907281

TRINH, B EXAMINER

12M2/0823

MORGAN & FINNEGAN, CALVERTI  
555 THIRTEENTH STREET, N.W.  
100 WEST  
WASHINGTON, D.C. 20004-1102

ART UNIT

PAPER NUMBER

1203

7

DATE MAILED: 08/23/94

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined  Responsive to communication filed on 12-23-94  This action is made final.

A shortened statutory period for response to this action is set to expire \_\_\_\_\_ month(s), 30 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

1.  Notice of References Cited by Examiner, PTO-892. 2.  Notice re Patent Drawing, PTO-948.  
3.  Notice of Art Cited by Applicant, PTO-1449. 4.  Notice of Informal Patent Application, Form PTO-152.  
5.  Information on How to Effect Drawing Changes, PTO-1474. 6.  \_\_\_\_\_

**Part II SUMMARY OF ACTION**

1.  Claims 1 - 5, 13, 24, 30-54, 62, 73, 79-97 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2.  Claims 6 - 12, 14 - 23, 25 - 29, 55 - 61, 63 - 72, 74 - 78 have been cancelled.

3.  Claims \_\_\_\_\_ are allowed.

4.  Claims \_\_\_\_\_ are rejected.

5.  Claims \_\_\_\_\_ are objected to.

6.  Claims 1 - 5, 13, 24, 30-54, 62, 73, 79-97 are subject to restriction or election requirement.

7.  This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8.  Formal drawings are required in response to this Office action.

9.  The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are  acceptable.  not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10.  The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_ has (have) been  approved by the examiner.  disapproved by the examiner (see explanation).

11.  The proposed drawing correction, filed on \_\_\_\_\_, has been  approved.  disapproved (see explanation).

12.  Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has  been received  not been received  been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_

13.  Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14.  Other

14/3

EXAMINER'S ACTION

BEST AVAILABLE COPY

Art Unit 1203

Claims 1-5, 13, 24, 30-54, 62, 73, and 79-97 are pending.

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-4, 30-~~54~~<sup>53</sup>, and 79-97, drawn to compound,

compositions, and method of use, classified in Class 549, subclass 510.

II. Claims 5 and 54, drawn to a method of prepare compound I,  
classified in Class 549, subclass 510.

III. Claims 13 and 62, drawn to another method of prepare compound  
I, classified in Class 549, subclass 510.

IV. Claims 24 and 73, drawn to another method of prepare compound  
I, classified in Class 549, subclass 510.

The inventions are distinct, each from the other because of the  
following reasons:

Inventions of Groups II, III, or IV and Group I are related as process  
of making and product made. The inventions are distinct if either or both of  
the following can be shown: (1) that the process as claimed can be used to  
make other and materially different product or (2) that the product as claimed

2 H M

Art Unit 1203

can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as the process of U.S. 5,015,744 wherein an oxazinone reacts with the baccatin to give the compound I.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Frederick Calvetti on August 8, 1994 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

A facsimile center has been established in Group 1200, room 3C10. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or 305-3592.

Serial No. 08/162,984

-4-

Art Unit 1203

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Trinh whose telephone number is (703) 308-4545.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

*C. Warren Ivy*  
C. Warren Ivy  
Supervisory Patent Examiner  
Group 120

*BT*  
TRINH:jd  
August 19, 1994

144